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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/766,651 | 01/23/2001 | Takashi Nakayama | FF-0114US | 4303 |
| 21254 | 7590 | 12/28/2005 | EXAMINER | |
| MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817 | | | VENT, JAMIE J | |
| | | ART UNIT | | PAPER NUMBER |
| | | | | 2616 |

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/766,651 | NAKAYAMA, TAKASHI | |
| | Examiner Jamie Vent | Art Unit 2616 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 30 September 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-50 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-50 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Response to Arguments

In response to applicant's argument, Pages 13-15, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., recording of data onto a memory card) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

On page 16-17 applicant argues that there is no motivation or suggestion for the references to be combined. Examiner notes Column 9 Lines 35+ wherein the advertisement is noted to be placed onto various mediums, including video mediums for added uses of the advertisement. Furthermore, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Although, all of applicants points are understood the examiner can not agree and therefore the rejection is maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,4-7,9-17,23-37,40-49 are rejected under 35 U.S.C. 102(b) as being unpatentable by Yamauchi et al (US 6,020,982).

[claim 1]

In regard to Claim 1, Yamauchi et al, discloses an image data output apparatus for outputting to a second medium, which different type of medium than a first medium, image data recorded in the first medium received from a customer, the apparatus comprising:

- a reader for reading out the image data recorded in the first medium (Figure 1 shows the system wherein the image data is read);
- an output unit for outputting the image data to the second medium (Figure 1 shows the various output units in the form of recorders 802 and 803, monitors 801a-801c and printer 805);
- a digital contents storage unit for storing digital contents to be stored in the first medium (Figure 1 shows the digital recording medium in form of a memory card);
- a selector for selecting from a plurality of said digital contents to be provided to the customer based on a predetermined selection condition (Figure 1 shows the CPU which selects a plurality of digital contents); and

- a recorder for recording said selected digital contents in the first medium
(Figure 1 shows the disc and tape recorders (802 and 803)).

[claim 2]

In regard to Claim 2, Yamauchi et al, discloses an image data output apparatus, wherein the first medium comprises a memory card in which the image data is recorded by an image capturing apparatus that records and plays the image data (Figure 1 shows the output of the data through the first recording medium of the memory card 400).

[claim 4]

In regard to Claim 4, Yamauchi et al discloses an image data output apparatus wherein said digital contents storage unit stores said digital contents to be provided in the second medium along with the image data (Figure 1 shows a buffer memory 605 that stores contents before storage onto the second recording medium).

[claim 5]

In regard to Claim 5, Yamauchi et al discloses an image data output apparatus wherein said recorder records said selected digital contents in the second medium (Figure 1 shows the recording onto the second recording medium through elements 802 and 803).

[claim 6]

In regard to Claim 6, Yamauchi et al discloses an image data output apparatus the digital contents are selected by the customer (Figure 89 shows the image data output apparatus wherein the digital contents are selected by the customer).

[claim 7]

In regard to Claim 7, Yamauchi et al discloses an image data output apparatus wherein said digital contents are selected as not being displayed when being printed (Figure 88 shows the display properties wherein it is shown the contents are selected).

[claim 9]

In regard to Claim 9, Yamauchi et al discloses an image data output apparatus further comprising a customer information input unit inputting information relating to the customer for reference, and said selector selects said digital contents by referring said customer information (Figures 88 and 89 show the image data output which shows customer information).

[claim 10]

In regard to Claim 10, Yamauchi et al discloses an image data output apparatus further comprising customer condition storage for storing a condition relating to the customer as said predetermined selection condition, wherein said selector elects said digital contents collating said customer information with said customer Condition (Figure 90 shows the various retrieval modes based on various customers and/or recording mediums that are entered into the apparatus).

[claim 11]

In regard to Claim 11, Yamauchi et al discloses an image data output apparatus wherein the image data includes accessory data showing the environment of which the image data is recorded in the first medium, the image data output apparatus further comprising:

- an accessory data reader for reading said accessory data from image data (Figure 90 shows various accessory data for reading the various data from the system); and
- a recording condition storage unit for storing a recording condition associating said recorded environment with a recording (Figure 104a shows a recording conditions associated with various mediums); and
- format of said digital contents, wherein said selector comprises a recording condition collator for selecting said digital contents by collating said accessory data with recording condition (Figure 90 shows the formatting of the digital contents that is selected from the selector).

[claim 12]

In regard to Claim 12, Yamauchi et al discloses an image data output apparatus wherein said accessory data relates to the type of image capturing apparatus photographed image data, and said recording condition defines a recording format to be played by said image capturing apparatus (Figure 104a shows accessory data relates to the photographed image data).

[claim 13]

In regard to Claim 13, Yamauchi et al discloses an image data output apparatus further comprising an available memory detector for detecting available memory of the first medium, wherein said selector selects said digital contents based on said detected available memory (Figure 96a shows the memory detection unit available for various recording mediums).

[claim 14]

In regard to Claim 14, Yamauchi et al discloses an image data output apparatus further comprising a data size storage unit for storing a data size of said digital contents, wherein said selector selects said digital contents having a smaller data size than said available memory with said data size (Figure 105b shows the various data size storage unit wherein the selector selects the digital contents).

[claim 15]

In regard to Claim 15, Yamauchi et al discloses an image data output apparatus further comprising:

- an after-treatment condition input after-treatment condition showing whether or not to erase at least a part of the image data from the first medium after completing the reading of the image data from the first medium (Figure 117 shows an after-treatment condition wherein the system allows the recording medium to be copied to delete); and
- an eraser for erasing at least a part of the image data from the first medium based on said after-treatment condition (Figure 117 again shows erasing the various parts of the recorded streams).

[claim 16]

In regard to Claim 16, Yamauchi et al discloses an image data output apparatus further comprising:

- a display for displaying to the customer some of said digital contents as choices (Figure 1 shows the display device for the customer to see the various components of the system); and
- an operation control for selecting desired digital contents for recording the first medium from said digital contents (Figure 89 wherein the selecting the desired contents for recording the first medium).

[claim 17]

In regard to Claim 17, Yamauchi et al discloses an image data output apparatus wherein said operation control selects desired digital contents for providing to the second medium from said digital contents displayed said display (Figure 88 shows the operation control selects of the various components).

[claim 20]

In regard to Claim 20, Yamauchi et al discloses an image data output apparatus wherein the image capturing apparatus having camera display displaying some said digital contents as choices and a camera operation control for selecting desired digital contents from said digital contents displays said digital contents as said choices and records said digital contents by selecting with said camera operation control (Figure 88 shows the display of the image capturing apparatus wherein the user can select various operations).

[claim 21]

In regard to Claim 21, Yamauchi et al discloses an image data output system for outputting image data comprising:

- a first medium for recording the image data to be received by a shop for converting a medium and for recording digital contents to be received by a customer (Figure 1 shows the system wherein the customer can get the image through printed images or recorded images);
- a second medium for recording the image data and for recording image data to be received by the customer (Figure 1 shows the second recording medium wherein the disc recorder and tape recorder);
- a reader for reading out the image data recorded in said first medium (Figure 1 shows the system wherein the image data is read);
- an output unit for outputting the image data to said second medium (Figure 1 shows the various output units in the form of recorders 802 and 803, monitors 801a-801c and printer 805);
- a digital contents storage unit storing said digital contents that the shop provides the customer (Figure 1 shows the digital recording medium in form of a memory card);
- a selector for selecting from said digital contents storage unit said digital contents to be provided to the customer based on a predetermined selection condition (Figure 1 shows the CPU which selects a plurality of digital contents);

- a recorder for recording said selected digital contents in least one of said first and second medium (Figure 1 shows the disc and tape recorders (802 and 803); and
- an image capturing apparatus outputting customer information (Figure 1 shows an image capturing apparatus outputting to the customer) comprising:
- an information input unit for inputting by a user's operation information for the image data output apparatus to refer to when selecting said digital contents (Figure 1 shows the input unit of the memory card into the system); and
- recorder for recording said information along with the image data at least one of said first and second medium (Figure 1 shows the recording information along with image data from first and second mediums).

[claim 22]

In regard to Claim 22, Yamauchi et al discloses an image data output system as said image capturing apparatus comprises:

- a camera display for displaying digital contents as choices (Figure 88 shows the displaying of the digital contents); and
- camera operation control for selecting desired digital contents from said displayed digital contents (Figure 89 shows the operation of control for selecting various components of the recording medium).

[claim 23]

In regard to Claim 23 the limitations are previously discussed in Claim 1.

[claim 24]

In regard to Claim 24 the limitations are previously discussed in Claim 4.

[claim 25]

In regard to Claim 25 the limitations are previously discussed in Claim 5.

[claim 26]

In regard to Claim 26 the limitations are previously discussed in Claim 9.

[claim 27]

In regard to Claim 27 the limitations are previously discussed in Claim 6.

[claim 28]

In regard to Claim 28 the limitations are previously discussed in Claim 16.

[claim 29]

In regard to Claim 29 the limitations are previously discussed in Claim 17.

[claim 30]

In regard to Claim 30 the limitations are previously discussed in Claim 7.

[claim 31]

In regard to Claim 31 the limitations are previously discussed in Claim 10.

[claim 32]

In regard to Claim 32 the limitations are previously discussed in Claim 23.

[claim 33]

In regard to Claim 33 the limitations are previously discussed in Claim 13.

[claim 34]

In regard to Claim 34 the limitations are previously discussed in Claim 14.

[claim 35]

In regard to Claim 35 the limitations are previously discussed in Claim 15.

[claim 36]

In regard to Claim 36 the limitations are previously discussed in Claim 16.

[claim 37]

In regard to Claim 37 the limitations are previously discussed in Claim 17.

[claim 40]

In regard to Claim 40 the limitations are previously discussed in Claim 21.

[claim 41]

In regard to Claim 41 the limitations are previously discussed in Claim 22.

[claim 42]

In regard to Claim 42 the limitations are previously discussed in Claim 7.

[claim 43]

In regard to Claim 43 the limitations are previously discussed in Claim 9.

[claim 44]

In regard to Claim 44 the limitations are previously discussed in Claim 10.

[claim 45]

In regard to Claim 45 the limitations are previously discussed in Claim 11.

[claim 46]

In regard to Claim 46 the limitations are previously discussed in Claim 13.

[claim 47]

In regard to Claim 47 the limitations are previously discussed in Claim 14.

[claim 48]

In regard to Claim 48 the limitations are previously discussed in Claim 15.

[claim 49]

In regard to Claim 49 the limitations are previously discussed in Claim 16.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3,8,18,19,38,39, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al (US 6,020,982) in view of Litwin (US 6,374,228).

[claims 3 & 8]

In regard to Claims 3 and 8, Yamauchi et al discloses an image data output apparatus wherein said digital contents comprises various media streams; however, fails to disclose that the media streams could comprise of an advertisement information to be provided to the customer in exchange for a discount of the service rate for outputting the image data from the first medium to the second medium. Litwin discloses a system wherein paid advertisements are used at a discounted rate wherein if displayed/viewed the user gets a discount for viewing the advertisement as disclosed in Column 2 Lines 1-56. Thereby the user is given a privilege in a form of a discount to view the

advertisement and furthermore allowing the advertiser to make sure that the advertisement is viewed. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a image data apparatus, as disclosed by Yamauchi et al, and incorporate an advertisement discount service, as disclosed by Litwin, to allow for advertisements to be effectively displayed and viewed.

[claims 18 & 19]

In regard to Claims 18 and 19, Yamauchi et al discloses an image data output apparatus; however, fails to disclose that a calculator is used for calculating a price of said digital contents recorded in the first medium based on said predetermined selection condition. Litwin discloses an advertisement system that tracks the amount of times the advertisement is displayed/viewed in order to allow for payment to the user as disclosed in Column 8 lines 57+ through Column 9 Lines 1-14. The calculation allows for the determination of what advertisement was displayed and when it was viewed thereby allowing the system to determine the contents used for displaying. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use an image data output apparatus, as disclosed by Yamauchi et al, and further incorporate a paid advertisement system, as disclosed by Litwin.

[claim 38]

In regard to Claim 38 the limitations are previously discussed in Claim 18.

[claim 39]

In regard to Claim 39 the limitations are previously discussed in Claim 19.

[claim 50]

In regard to Claim 50 the limitations are previously discussed in Claim 18.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie Vent whose telephone number is 571-272-7384. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ju (l)
Jamie Vent
12/20/05

Robert Chah
ROBERT CHAH
PRIMARY EXAMINER